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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/538,041

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Jin-Soo Kim

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EXAMINER

DUNSTON, JENNIFER ANN

ART UNIT

PAPER NUMBER

1636

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/538,041

Applicant(s)

KIM ET AL.

Examiner

Jennifer Dunston

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

### DETAILED ACTION

Claims 1-29 are pending in the instant application.

#### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

**Group I**, claim(s) 1-11 and claims 16-19 (in part, as they read on the polypeptide of claim 1), drawn to a polypeptide comprising a DNA binding domain that includes a plurality of zinc finger domains, wherein the DNA binding domain can bind to a site in a VEGF gene.

**Group II**, claim(s) 12-13 and claims 16-19 (in part, as they read on the nucleic acid of claim 12), drawn to a nucleic acid encoding a polypeptide comprising a DNA binding domain that includes a plurality of zinc finger domains, wherein the DNA binding domain can bind to a site in a VEGF gene.

**Group III**, claim(s) 14-15, 20 and 21 and claims 16-19 (in part, as they read on the mammalian cell of claim 14), drawn to a modified mammalian cell that contains a nucleic acid sequence encoding a chimeric zinc finger protein that regulates the production of a secreted factor.

**Group IV**, claim(s) 22-27 (in part, as they read on the polypeptide of claim 1) and claims 28-29 (in part, as they read on the polypeptide of claim 16), drawn to a method of regulating VEGF gene expression, comprising introducing a polypeptide into a cell.

**Group V**, claim(s) 22-27 (in part, as they read on the nucleic acid of claim 12) and claims 28-29 (in part, as they read on the nucleic acid of claim 16), drawn to a method of regulating VEGF gene expression comprising introducing a nucleic acid into a cell.

**Group VI**, claim(s) 28-29 (in part, as they read on the cell of claim 16), drawn to a method of modulating angiogenesis in a subject comprising administering a mammalian cell.

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The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

According to PCT Rule 13.2, unity of invention exists only when the shared same or corresponding technical feature is a contribution over the prior art. The inventions listed as Groups I-VI do not relate to a single general inventive concept because they lack the same or corresponding special technical feature. The technical feature linking Groups I-VI appears to be that they all relate to DNA binding domains that include a plurality of zinc finger domains, which can bind to a gene encoding a secreted factor. However, Liu et al (The Journal of Biological Chemistry, Vol. 276, No. 14, pages 11323-11334, April 2001) teach DNA binding domains comprising three zinc fingers, where the zinc fingers regulate the expression of VEGF-A, a secreted factor (e.g., Table II). Therefore, the technical feature linking the inventions of Groups I-VI does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art.

The special technical feature of Group I is considered to be a polypeptide.

The special technical feature of Group II is considered to be a nucleic acid molecule.

The special technical feature of Group III is considered to be a mammalian cell.

The special technical feature of Group IV is considered to be administering a polypeptide to a subject.

The special technical feature of Group V is considered to be administering a nucleic acid to a subject.

The special technical feature of Group VI is considered to be administering a cell to a subject.

The polypeptide, nucleic acid molecule, and cell each have distinct structures that result in distinct biological properties. Accordingly, Groups I-VI are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

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DNA binding domains that include a plurality of zinc finger domains, wherein the zinc finger domains each include respective zinc finger domain motifs listed in column 2 of Table 1, Table 2, Table 3, Table 4 or Table 5, and/or in claims 4, 6 or 19.

Applicant is required, in reply to this action, to elect a single species (one combination of zinc finger domains) to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

Claims 1, 4, 6 and 19 are claimed in a Markush-type format. According to PCT Rule 13.2 and to the guidelines in Section (f)(i)(A) and Section (f)(i)(B)(1) of Annex B of the PCT Administrative instructions, all alternatives of a Markush group must have a common property or activity and a common structure. The nucleic acid sequences of the abovementioned claims each have a different chemical structure and do not share a common structure. Each combination of zinc finger domains listed in column 2 of Tables 1-5 have a unique structure defined by the DNA contacting residues at positions -1, +2, +3 and +6 for zinc fingers 1-3 or zinc fingers 1-4. Furthermore, the nucleic acid sequences do not share a common property or activity in that the variation in the DNA contacting residues will result in different protein-DNA contacts and different binding affinities.

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Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

### ***Rejoinder Practice***

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully

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examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Dunston whose telephone number is 571-272-2916. The examiner can normally be reached on M-F, 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached at 571-272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jennifer Dunston, Ph.D.  
Examiner  
Art Unit 1636

/JD/

CELINE QIAN, PH.D.  
PRIMARY EXAMINER

